

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GORKEM I. ATES

Appeal No. 2004-1463
Application 09/401,221

ON BRIEF

Before JERRY SMITH, RUGGIERO and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-6, which constitute all the claims in the application.

The disclosed invention pertains to an Internet system and to a method for using an Internet system.

Representative claim 1 is reproduced as follows:

1. An Internet system, comprising:
 - a) a main server for storing information to be requested over the Internet by a client so as to form a request for information and having an IP address; and
 - b) at least one participant server having an IP address and electrically communicating with said main server; said at least one participant server not receiving the request for information from the client, but rather said main server receiving the request for information over the Internet from the client and requesting over the Internet that said at least one participant server send the requested information over the Internet back to the client, and if said at least one participant server does not have the requested information, the requested information is downloaded from said main server to said at least one participant server, and when said at least one participant server sends the requested information over the Internet back to the client, said at least one participant server assigns to the requested information said IP address of said main server and not said IP address of said at least one participant server.

The examiner relies on the following references:

Brendel et al. (Brendel)	5,774,660	June 30, 1998
Leighton et al. (Leighton)	6,108,703	Aug. 22, 2000
		(filed May 19, 1999)

Claims 1-6 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Brendel in view of Leighton.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the examiner has failed to provide a record which supports the rejection. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one

having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments

actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner has indicated how he finds the claimed invention to be obvious over the collective teachings of Brendel and Leighton [answer, pages 3-11]. With respect to independent claims 1 and 4, appellant essentially argues that 1) there is no motivating suggestion that the teachings of Brendel can be incorporated with the teachings of Leighton as suggested by the examiner, and 2) that the applied prior art fails to teach that the main server requests over the Internet that the participating server send the requested information over the Internet to the client. With regard to the latter point, appellant argues that a WAN, as suggested by Brendel, is not equivalent to the Internet [brief, pages 12-31]. With respect to the first argument, the examiner responds that the motivation for combining the references resides in their mutual desire to make Internet communications more efficient. With respect to the second argument, the examiner responds that a WAN and the Internet are both types of communication mediums used [answer, pages 11-14].

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Appellant responds that the WAN taught by Brendel does not suggest the Internet as claimed [reply brief].

We will not sustain the examiner's rejection of claims 1-6 because the examiner has failed to establish a prima facie case of obviousness. Although we do not agree with appellant's argument regarding the recitation of the Internet in the claimed invention, we do agree with appellant that the record in this case does not support the combination of Brendel and Leighton. With respect to the question of the use of the Internet, appellant relies on the rule that a genus (WAN) cannot reject a species (the Internet). The correct rule, however, is that a genus does not necessarily reject a species. A genus may not reject a species when the species (as claimed) may be an unknown member of the genus. However, if the species is a known member of the genus, then the species may be obvious over the teaching of the genus. In this case, it is well known in this art that the Internet is considered to be one form of a WAN. Therefore, appellant's argument that the WAN of Brendel would not have suggested the claimed Internet is not persuasive.

We do find, however, that the examiner's basis for combining the teachings of Leighton with the teachings of Brendel is not supported on this record. Brendel teaches a web server system in which the load on the system is balanced when a plurality of participating servers are used. The load balancer sends web requests to one of the participating servers which has the requested web information. Thus, the selected participating server in Brendel always has the requested information. The claimed invention requires that the main server send the requested information to the participating server when the selected participating server does not have the requested information. As noted above, since the selected participating server in Brendel always has the requested information, there is no reason for the main server to ever perform this function. Despite this clear fact, however, the examiner proposes to modify Brendel in the event that the requested information is not present at the selected participating server. It is based on this alleged happening that the examiner proposes to modify Brendel with the teachings of Leighton. The examiner's concern, however, that Brendel needs to be modified to accommodate the possibility that the selected participating server would not have the requested information lacks merit because this condition

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cannot happen in Brendel. Therefore, the examiner's analysis in support of the combination of Brendel with Leighton is not based on anything within the teachings of these references. The examiner, therefore, is simply trying to reconstruct the claimed invention in hindsight.

In summary, the examiner's rejection of the claims on appeal is not supported on the record before us. Therefore, the decision of the examiner rejecting claims 1-6 is reversed.

REVERSED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

JOSEPH F. RU

JOSEPH F. RUGGIERO
~~Administrative Patent Judge~~

LANCE LEONARD BARRY
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